Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte THOMAS A. KAYL

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Appeal No. 2000-2293
Application No. 08/685,162[1]

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ON BRIEF

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Before FLEMING, GROSS, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-32, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellant's invention is directed to a disc operating device in which a housing and a disc holding tray are connected by a break-away mechanism for preventing damage to the tray in its

[1] Application for patent filed July 23, 1996.

extended position upon impact of an external force. As depicted in figure 1B, the disc operating device includes housing 12 that contains multi-part disc holding tray 15 (specification, page 5). The tray has a moveable first portion 16 that engages with the housing and, through break-away mechanism 20, is coupled to second portion 18 for holding a disc (id.). Thus, any external contact force that would normally damage the disc holding tray is isolated from moveable tray portion 16 by the break-away mechanism.

Representative independent claim 1 is reproduced below:

1. A disc operating device comprising:

a housing supporting a disc information handling mechanism; and

a disc holding tray, further comprising:

a first portion substantially internal and movable within the housing of the disc operating device;

a second portion, for supporting a disc, that extends and retracts from the housing; and

a break-away mechanism coupling the first portion to the second portion, the break-away mechanism being adapted for preventing damage to the disc holding tray upon impact of an external force to the second portion when the second portion is extended from the housing.

The Examiner relies on the following references in rejecting the claims:

Sasaki[2]	61-94262	May 13, 1986
Kawamura et al. (Kawamura)	5,737,293	Apr. 7, 1998 (filed Sep. 19, 1995)

Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasaki in view of Kawamura.

Rather than reiterate the viewpoints of the Examiner and Appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 19, mailed March 17, 2000) for the Examiner's reasoning, and to the appeal brief (Paper No. 18, filed February 2, 2000) and the reply brief (Paper No. 20, filed May 19, 2000) for Appellant's arguments thereagainst.

OPINION

Appellant argues that one skilled in the art would not be motivated to combine Sasaki and Kawamura since the references solve separate problems which are also different from the one solved by Appellant (brief, page 7). Appellant further points out that Sasaki's disk table is connected by a fulcrum shaft to a supporter and rotates around the shaft when extended out in order

[2] Translation of this Japanese Kokai reference (provided by Schreiber Translations, Inc.) is relied upon and accompanies this decision.

to facilitate the loading of disks in case the player is at a high place (brief, pages 6 & 7). Referring to Kawamura, Appellant argues that holding hooks 20, located at the end of a pair of spring reeds 22, are only for grabbing a bare disc or hooking onto notches in a disc cartridge when either a disc or a cartridge is inserted (brief, page 7). Additionally, Appellant asserts that even if the holding hooks of Kawamura were combined with the tilting tray of Sasaki, the result would not have taught the claimed break-away mechanism adapted for preventing damage to the disk holding tray upon impact of an external force (brief, page 8).

In response to Appellant's arguments, the Examiner asserts that Kawamura discloses a break-away mechanism as coupling 20 which "inherently shows that the break-away mechanism is adapted for preventing damage to the disc holding tray upon impact of the external force as claimed because elastically material is flexible" (answer, page 6). The Examiner reasons that since Kawamura shows the break-away mechanism for preventing damage to the disc holding tray, it would have been obvious to adapt Sasaki's break-away mechanism for preventing damage to the disc holding tray as taught by Kawamura (id.).

The initial burden of establishing reasons for unpatentability rests on the Examiner. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration, consistent with the holding in Graham v. John Deere Co., 383 U.S. 1 (1966). Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966). However, "the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Our review of Sasaki confirms that the reference relates to a disk loading device with a tilting disk tray that allows easily installing and removing disks when the player is at a high place. As depicted in Figure 6, disk table 20 advances from and retreats back into opening 12 on the front of the disk player main body 11 (page 5). In its extended position, disk table 20 rotates around a hinge formed by fulcrum shaft 36 and fulcrum hole 37 on both

sides of the tray to a tilted position (page 7 and fig. 5). It is clear from the disclosure of Sasaki that, when extended outward, the table remains in its tilted position all the time. Therefore, the rotating hinge of Sasaki is not a break-away mechanism that couples the first internal portion within the housing to the second disc supporting portion for preventing damage to the disk holding tray upon impact of an external force. In fact, Sasaki provides for coupling a disk tray to the housing through a hinge that forces the tray into a tilted position when extended from the housing.

Kawamura, on the other hand, relates to a disc loading apparatus that allows loading either a naked disc or a disc cartridge. The disclosed apparatus includes a housing with an opening in the front, side walls that function as slide guide for holding means 2 and as control rail for regulating the opening and closing of holding hooks 20 into wall recesses 7 (Fig. 1 and col. 4, lines 1-13). As depicted in Figures 6-9, the edges of disc 12 press against holding hooks 20 and push them into recesses 7 as a naked disc is inserted in the opening, and allow hooks 20 to take their original position and hold the edge of the disc as the disc is completely positioned inside the holding means (col. 6, lines 21-36). Kawamura in Figures 10-13 further

teaches that a disc cartridge 9 may alternatively be used that presses outwardly against holding hooks 20 until the cartridge advances into the housing and hooks 20 return to fit into notches 10 on the sides of the cartridge (col. 6, line 62 to col. 7 line 2). However, our review of the reference reveals no teaching related to using the holding hooks as a break-away mechanism for preventing damage to the disc holding tray upon impact of an external force when the disc supporting portion is extended from the housing, as recited in claim 1.

As the Federal Circuit states, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The court further reasons in Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) that for an invention to be obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.

See also In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Based on these well-settled principles, we disagree with the Examiner that, because Kawamura's holding hooks 20 elastically fit around a naked disc or on holding notches of a disc cartridge, the hooks constitute the break-away mechanism for preventing damage to the disc holding tray. The Examiner's position is that the elastic holding hooks of Kawamura form a break away mechanism that is inherently adapted for preventing damage to the disc holding tray and may be combined with the rotating hinge of Sasaki. Although Sasaki discloses a tilting disc holding tray, the Examiner has failed to establish why one of ordinary skill in the art would have found it obvious to use the holding hooks of Kawamura with the disk table of Sasaki.

Even if the Examiner is contending that holding hooks 20 of Kawamura prevent damage to the inserted disc or the cartridge, such protection is available only when the disc or the cartridge is inserted in the housing. The holding hooks, at best, prevent damage to the tray from its own lateral movement, but not from external force when the disc supporting portion of the tray is extended from the housing. Kawamura, in fact, merely discloses a mechanism having elastic hooks for receiving a disc or a

cartridge without any rotational functions while Sasaki provides for a disc table that tilts about a hinge that connects the disc table to a table support placed within the main body of the disc player. We agree with Appellant (reply brief, page 2) that nothing in the references would have taught or motivated one of ordinary skill in the art to use the hooks of Kawamura in the tilting tray of Sasaki to form a break-away mechanism that couples the moveable portion to the disc supporting portion of the holding tray and is adapted for preventing damage to the tray from external forces, as recited in claim 1.

We note that independent claim 18 also recites a disc supporting tray including a break-away mechanism attached to the disc holding portion via an intermediate coupling portion. Independent method claim 31 similarly requires the step of coupling a disc supporting tray, via a break-away mechanism, to a moveable tray withing the housing such that the disc supporting tray extends out from the housing. Similar to claim 1, these two claims require that the break-away mechanism be adapted for preventing damage to the disc holding/supporting portion upon impact of an external force to the tray. As discussed above with respect to claim 1, Sasaki and Kawamura fail to disclose or suggest the claimed break-away mechanism for preventing damage to

the disc holding tray upon impact of an external force when the disc supporting portion is extended from the housing.

Based on our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the necessary teachings and suggestions to combine the holding hooks of Kawamura with the tilting disk tray of Sasaki and form the claimed break-away mechanism, are not shown. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of independent claims 1, 18 and 31, as well as claims 2-17, 19-30 and 32 dependent thereon, over Sasaki and Kawamura.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-32 under 35 U.S.C. § 103 is reversed.

REVERSED

MICHAEL R. FLEMING Administrative Patent Judge	)	
ANITA PELLMAN GROSS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MAHSHID D. SAADAT Administrative Patent Judge	)	

MDS/ki

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